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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,639	05/16/2006	Peter Tunguy-Desmarais	5288-0102PUS1	8755

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EXAMINER
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KARPINSKI, LUKE E

ART UNIT	PAPER NUMBER
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1616

NOTIFICATION DATE	DELIVERY MODE
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06/06/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/562,639	<b>Applicant(s)</b> TUNGUY-DESMARAIS, PETER	
	<b>Examiner</b> LUKE E. KARPINSKI	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/10/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claims*

Claims 1-9 are currently pending and under consideration in this action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte*

*Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 6 and 7 recite the broad recitation "Tea Tree oil", and the claim also recites "*Melaleuca alterifolia*" which is the narrower statement of the range/limitation. Tea Tree oil is broad because the oil may also be extracted from *Melaleuca dissitiflora* and *Melaleuca linariifolia*.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**1. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b)** as being anticipated by US Patent No. 4,073,937 to Van Cleave.

Van Cleave discloses a method for the treatment of "swimmer's ear", which is a water related outer ear canal disorder (background), comprising the application of a composition (abstract) comprising a water insoluble film forming agent , which reads on water resistant, (col. 4, lines 1-10, 21-29, and 50-65) and an antimicrobial agent (col. 4, lines 21-29) as claimed in claim 1.

Van Cleave further discloses a composition comprising a water repellent agent (col. 4, lines 1-10, 21-29, and 50-65) and an antimicrobial agent (col. 4, lines 21-29) in a film forming liquid (col. 3, lines 50-59 and figures 4 and 5) capable of being instilled in the outer ear in droplet form (figure 4) as claimed in claim 2. Van Cleave also discloses a natural antimicrobial agent capable of acting against a broad range of bacterial and

fungal infections (boric acid) (col. 5, lines 57-61) as claimed in claim 5. Boric acid is a known anti-bacterial and anti-fungal which exists naturally in sea-water and most fruits.

**2. Claims 2-9 are rejected under 35 U.S.C. 102(b)** as being anticipated by US Patent No. 6,387,382 to Saleh et al.

Saleh et al. disclose a composition comprising a water repellant agent (siloxane polymer) (abstract) and an anti-microbial agent (tea tree oil) (col. 7, lines 56-65) in a film forming liquid (col. 1, lines 63-67) as claimed in claim 2. Regarding the limitation of the composition as capable of being instilled in the outer ear canal in droplet form, the compositions are to liquid preparations (col. 3, line 66 to col. 4, line 6) and a liquid formulation is inherently capable of being instilled in the outer ear canal in droplet form.

Saleh et al. further disclose a silicone polymer as the film forming liquid (col. 1, lines 63-67 and col. 2, line 54 to col. 3, line 15) as claimed in claim 3; a polysiloxane (col. 2, line 54 to col. 3, line 15) as claimed in claims 4 and 7; a natural anti-microbial capable of acting against a broad range of bacterial and fungal infections (col. 7, lines 42-64) as claimed in claims 5, 8, and 9; tea tree oil (col. 7, lines 42-64) as claimed in claims 6 and 7.

**3. Claims 2-4 are rejected under 35 U.S.C. 102(b)** as being anticipated by European Patent Application Publication No. 0576748 to Merat et al.

Merat et al. disclose a composition comprising a water repellant agent (poly[oxy(dimethylsilylene)]) and an anti-microbial agent (benzalkonium chloride) (page

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5, example 7) in a film forming liquid (page 2, lines 42-47) as claimed in claim 2.

Regarding the limitation of the composition as capable of being instilled in the outer ear canal in droplet form, the compositions are to fluid preparations (page 2, lines 42-47) and a fluid formulation is inherently capable of being instilled in the outer ear canal in droplet form.

Merat et al. further disclose the water repellent agent constituted by a water repellent silicone polymer, which is a polysiloxane (page 3, lines 20) as claimed in claims 3 and 4.

**4. Claim 2 is rejected under 35 U.S.C. 102(b)** as being anticipated by International Application Publication No. WO98/29085 to Bettel et al.

Bettel et al. disclose a composition comprising a water repellent agent and an anti-microbial agent (page 7, lines 1-14) in a film forming liquid (abstract) as claimed in claim 2. Regarding the limitation of the composition as capable of being instilled in the outer ear canal in droplet form, one embodiment of the formulations is as a lotion (page 5, lines 28-31) and a lotion is inherently capable of being instilled in the outer ear canal in droplet form.

### ***Conclusion***

Claims 1-9 are rejected.

No claims are allowed.

***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Thursday 9-4 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Mina Haghighatian/  
Primary Examiner  
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